

REMARKS/ARGUMENTS

Applicants respectfully request reconsideration and allowance of this application in view of the following comments.

At the outset, Applicants wish to address the showing required by 37 CFR § 1.116(b) as to why this amendment is necessary and was not presented earlier. This amendment is necessary to remove the remaining issues, and is responsive to new points made in the final rejection. Since this is the first substantive response to the final rejection, this amendment could not have been presented earlier. In view of the foregoing, Applicants respectfully request that the Examiner enter and consider this amendment. An early notice that this amendment has been entered and considered is earnestly solicited.

Claims 1-3, 5, 6, 8 and 9 were rejected under 35 USC § 103(a) as being obvious over Ruebel, US 6,852,207, in view of Ehrhardt, US 3,307,972, and Palaika et al. ("Palaika"), US 6,248,225.

Claim 4 was rejected under 35 USC § 103(a) as being obvious over Ruebel in view of Ehrhardt and Palaika and further in view of Grenon, US 4,251,327.

Claim 7 was rejected under 35 USC § 103(a) as being obvious over Ruebel in view of Ehrhardt and Palaika and further in view of Kyriacou et al. ("Kyriacou"), US 4,217,185.

In response to *all three* obviousness rejections, Applicants submit that the cited

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combinations of references do not make out a *prima facie* case of obviousness. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw all three obviousness rejections.

Towards the bottom of page 7 of the Office Action, the Examiner writes:

“Ruebel’s *silence* with respect to the specific heating means suggests to one of ordinary skill in the art that any heating means would be suitable for heating the electroplating solution.”

In response, Applicants point out that Ruebel is *not* silent with respect to the specific heating means to be used. Ruebel teaches at column 7, lines 31 ff, that “[t]he apparatus used for deposition is constructed essentially as shown in the drawings and comprises a *heatable magnetic stirrer* * * *.” Thus, Ruebel contemplates heating with a heatable magnetic stirrer, and, therefore, does not suggest to one of ordinary skill in the art that any heating means would be suitable.

The Examiner states in the sentence bridging pages 7-8 of the Office Action that:

“It would have been obvious to one having ordinary skill in the art * * * to have replaced the heating means of Ruebel by using the infrared lamp of Ehrhardt, because using an infrared lamp increases the rate of electrodeposition.”

Applicants respectfully submit that this is a red herring. Ehrhardt makes no mention of Ruebel’s heatable magnetic stirrer. Consequently, Ehrhardt contains no teaching or suggestion that replacing Ruebel’s heatable magnetic stirrer with Ehrhardt’s infrared lamp would be expected to increase the rate of electrodeposition relative to Ruebel’s heatable magnetic stirrer.

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Rather, Ehrhardt's improvement is, presumably, vis-à-vis an *unheated* sample, i.e., Ruebel teaches that heating with an infrared lamp increases the rate of electrodeposition vis-à-vis a sample not heated. Accordingly, the record is devoid of any teaching or suggestion why it would have been desirable to substitute Ruebel's heatable magnetic stirrer with Ehrhardt's infrared lamp.

Moreover, as reaffirmed by the Court in *In re Regel et al.*, 188 USPQ 136, 139, footnote 5 (CCPA 1975):

"The mere fact that it is *possible* to find two isolated disclosures which might be combined in such a way to produce a new compound does not necessarily render such production obvious *unless the art also contains something to suggest the desirability of the proposed combination.*"

This record contains absolutely nothing to teach or suggest why it would have been desirable for a person having ordinary skill in the art to replace Ruebel's heatable magnetic stirrer with Ehrhardt's infrared lamp. In the absence of such evidence of desirability to make the substitution, the cited combination of references does not make out a *prima facie* case of obviousness.

Even assuming, merely for the sake of argument, that there were sufficient motivation—which Applicants do not believe there was—the record reflects unexpected results attributable to the claimed invention. Thus, it is shown in the specification, for example, in the fourth paragraph on page 4 and in the fourth paragraph on page 7 that the heating times achieved with the use of the infrared lamp are 3 to 5 times shorter than those achieved using thermal conduction

(which is involved in Ruebel's heatable magnetic stirrer embodiment). As noted above, the prior art does not discuss the relative merits of heatable magnetic stirrers versus infrared lamps. Given this silence, the showing in the specification must be considered surprising and unexpected, and, therefore, as objective evidence of nonobviousness.

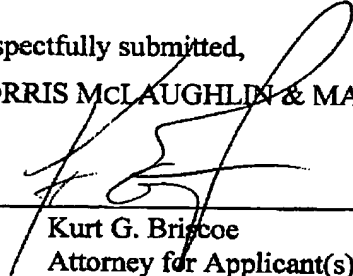
In short, Applicants respectfully submit that this rejection is untenable. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance. However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,
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